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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/495,715      | 02/01/2000  | Hideyuki Miyata      | 1480.1003           | 5208             |

21171 7590 02/27/2003

STAAS & HALSEY LLP  
700 11TH STREET, NW  
SUITE 500  
WASHINGTON, DC 20001

EXAMINER

FAHMY, SHERIF R

ART UNIT

PAPER NUMBER

2633

DATE MAILED: 02/27/2003

*Re Start*

Please find below and/or attached an Office communication concerning this application or proceeding.



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## Office Action Summary

Application No.

09/495,715

Applicant(s)

MIYATA ET AL.

Examiner

Sherif R. Fahmy

Art Unit

2633

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2003.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 and 11-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6, 7 and 9 is/are rejected.
- 7) ☒ Claim(s) 8 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☒ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2                      6) ☐ Other: \_\_\_\_\_

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*Election of Species*

1. In a telephonic interview on Jan. 28, 2003, Attorney Paul I. Kravetz, Reg. No. 35,230, representing applicant, agreed that the claims indicated in "Response to Election/Restriction Requirement" filed Jan. 8, 2003, did not correspond to the elected species. Accordingly, we have agreed that claims 6-10 corresponding to a single species represented in fig. 4 and fig. 6 will be considered in this first action on the merits, not claims 1-12 as had been previously indicated in applicant's response.

*Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 6 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Terahara.

Regarding claim 6, Terahara teaches an optical communication apparatus comprising an optical modulating means (16) for modulating input light in accordance with a modulation signal to be transmitted and a regulating means (58) for regulating the intensity of light which is transmitted through an optical transmission line from said optical modulation means (output from 58 on transmission lines. (See fig. 13, fig. 5).

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Regarding claim 9, said regulating means is an optical attenuating means (58) for attenuating the intensity of light exit from an output port of said optical modulating means in accordance with the intensity of light in said optical modulating means.

4. Claim 6-7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Nagakubo et al.

Regarding claim 6, Nagakubo teaches an optical communication apparatus comprising an optical modulating means (2) for modulating input light in accordance with a modulation signal to be transmitted and a regulating means (20) for regulating the intensity of light which is transmitted through an optical transmission line from said optical modulation means, (fig. 14).

Regarding claim 7, said regulating means is an optical attenuating means (20), for attenuating intensity of light entered to an input port of said optical modulating means in accordance with the intensity of light in said optical modulating means (1). Transmission occurs over a transmission line inherently, since the invention disclosed in Nagakubo is specifically directed to communication systems that use optical fibers (col. 1- lines 1-35).

***Allowable Subject Matter***

5. Claims 8 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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*Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mita and Roberts are cited for disclosing similar techniques of stabilizing the light output of an optical modulator using optical attenuating means.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sherif R. Fahmy whose telephone number is 703-305-8088. The examiner can normally be reached on 8:30AM-6:00PM(Mo-Th) 8:30AM-5:00PM(2nd & 4th Fr).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan can be reached on 703-305-4729. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3988 for regular communications and 703-305-3988 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4800.

SRF  
February 5, 2003

*Leslie Pascal*  
LESLIE PASCAL  
PRIMARY EXAMINER